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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,790	11/30/2001	David Leigh Donoho	UNIV0001D3-C	6114
22862	7590	04/28/2005	EXAMINER	
GLENN PATENT GROUP 3475 EDISON WAY, SUITE L MENLO PARK, CA 94025			CARDONE, JASON D	
			ART UNIT	PAPER NUMBER

2145

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/997,790

**Applicant(s)**

DONOHO ET AL.

**Examiner**

Jason D. Cardone

**Art Unit**

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is responsive to the amendment of the applicant, filed on 2/4/05.

Claims 1-41 are presented for further examination.

2. The terminal disclaimer filed on 2/4/05 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of 6,263,362 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dasan, USPN 5,761,662, in view of Rose et al. "Rose", USPN 5,724,567.

5. Regarding claim 1, Dasan discloses a method for inspecting any of the properties of a computer, the computer's configuration, contents of the computer's storage devices, the computer's peripherals, the computer's environment, or remote affiliated computers, comprising the steps of:

providing at least one inspector library, which includes at least one inspector and associated methods [ie. user profiles, Dasan, col. 6, lines 1-19], evaluating

subexpressions with the at least one inspector [ie. using user profile, Dasan, col. 6, lines 20-60].

Dasan does not specifically disclose the inspector performing any of mathematico-logical calculations, executing computational algorithms, returning results of system calls, accessing contents of storage devices, and querying devices or remote computers to inspect any of the properties of the computer, the computer's configuration, contents of the computer's storage devices, the computer's peripherals, the computer's environment, or remote affiliated computers. However, Rose, in the same field of endeavor, discloses an inspector that performs mathematico-logical calculations and querying devices or remote computers [ie. server (10), Rose, col. 3, lines 37-65 and col. 6, line 62 - col. 7, line 62]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate mathematico-logical calculations, taught by Rose, in to the newspaper generator, taught by Dasan, since Rose suggests that text retrieval for users, similar to the text retrieval disclosed by Dasan, can have the ability to direct relevant messages [Rose, col. 1, line 65 - col. 2, line 16]. One of ordinary skill in the art would have been motivated to modify Dasan to include the mathematico-logical calculations in view of Rose, so that the user may see the most relevant message available.

6. Regarding claim 2, Dasan-Rose further discloses providing an inspector dispatcher associated with an advice client computer for continually performing relevance determination; wherein the relevance determination is driven by a database

of relevance clauses, which can be continually evaluated [Dasan, col. 6, lines 20-60] [Rose, col. 3, lines 37-65 and col. 6, line 62 - col. 7, line 62].

7. Regarding claim 3, Dasan-Rose further discloses sending certain relevance clauses to a remote location, evaluating the clauses, and returning the clauses after a user is made aware of what is being transferred, wherein properties of the remote location are learned [Dasan, col. 6, lines 1-19] [Rose, col. 3, lines 37-65 and col. 6, line 62 - col. 7, line 62].

8. Regarding claim 4, Dasan-Rose further discloses relevance evaluation is driven in a master-slave relationship by a master machine, which tells a slave machine to evaluate a relevance clause [Dasan, col. 7, line 61 – col. 8, line 21] [Rose, col. 3, lines 37-65 and col. 6, line 62 - col. 7, line 62].

9. Regarding claim 5, Dasan-Rose further discloses properties, which can be learned, are elementary properties that are determined according to basic calculations [Dasan, col. 6, lines 20-60] [Rose, col. 3, lines 37-65 and col. 6, line 62 - col. 7, line 62].

10. Regarding claim 6, Dasan-Rose further discloses the at least one inspector is built into the inspector dispatcher [ie. newspaper generator, Dasan, col. 5, line 53 - col. 6, line 9] [Rose, col. 3, lines 37-65].

11. Regarding claim 7, Dasan-Rose further discloses providing one or more caches for avoiding heavy CPU and disk access overhead while successfully performing the continual relevance evaluation [Dasan, col. 7, line 61 – col. 8, line 21] [Rose, col. 3, lines 37-65 and col. 6, line 62 - col. 7, line 62].

12. Regarding claim 8, Dasan-Rose further discloses an object, property name, and/or string selector is dispatched to the inspector dispatcher for relevance evaluation using a method dispatch module in accordance with dispatch information contained within a method dispatch table [Dasan, col. 5, line 53 - col. 6, line 9] [Rose, col. 3, lines 37-65].

13. Regarding claim 9, Dasan-Rose further discloses parsing a clause in a relevance language, generating a list of method dispatches in response to the parsing step, wherein specific methods are called in a specific order with specific argument lists; and systematically carrying out a sequence of method dispatches in an appropriate order [Dasan, col. 6, lines 20-60] [Rose, col. 3, lines 37-65 and col. 6, line 62 - col. 7, line 62].

14. Regarding claims 10-41, claims 10-41 have similar limitations as claims 1-9. Therefore, they are rejected under Dasan-Rose for the same reasons set forth in the rejection of claims 1-9 [Supra 1-9].

***Response to Arguments***

15. Applicant's arguments filed 2/4/05 have been fully considered but they are not persuasive.

16. (A) Rose fails to teach at least one inspector "performing any of mathematico-logical calculations, executing computational algorithms, returning results of system calls, accessing contents of storage devices, and querying devices or remote computers to inspect any of the properties of the computer".

As to point (A), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Dasan substantially discloses the claimed invention. Dasan does not specifically disclose the list of limitations above. Rose does not have to teach all the limitations listed after "performing" since the limitation has "any of" with it. Rose only has to disclose one of the limitations. Rose does disclose an inspector that performs mathematico-logical calculations and querying devices or remote computers [ie. server (10), Rose, col. 3, lines 37-65 and col. 6, line 62 - col. 7, line 62].

17. (B) Impermissible hindsight.

As to point (B), in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made,

and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate mathematico-logical calculations, taught by Rose, in to the newspaper generator, taught by Dasan, since Rose suggests that text retrieval for users, similar to the text retrieval disclosed by Dasan, can have the ability to direct relevant messages [Rose, col. 1, line 65 - col. 2, line 16]. One of ordinary skill in the art would have been motivated to modify Dasan to include the mathematico-logical calculations in view of Rose, so that the user may see the most relevant message available.

### ***Conclusion***

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.



19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason D. Cardone whose telephone number is (571) 272-3933. The examiner can normally be reached on Mon.-Thu. (6AM-3PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (571) 272-6159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason D Cardone  
Primary Examiner  
Art Unit 2145

April 27, 2005